

## **REMARKS**

Claims 1-20 are presented for examination.

### **§103 Rejections**

In the present Office Action, the Examiner rejected claims 1-29 under 35 U.S.C. 103(a) as being unpatentable over US Patent Application 2002/0174355 (*Rajasekaran*) in view of *Song et al.* Applicants respectfully traverse this rejection.

One or more embodiments described in the patent application are directed to allowing a user to perform confidential searches without revealing the contents of the term to be searched. In one embodiment, the patent application describes encrypting the search term using an encryption algorithm before it is transmitted to a search engine module, which then compares the encrypted search term to other encrypted terms accessible to the search engine. Because the search is conducted based on an encrypted search term, as opposed to plain text form of the search term, a search can be conducted while keeping the original search term relatively confidential. Against this general backdrop, the claims are discussed next.

For ease of illustration, claim 15 is discussed first. Claim 15 calls for a control unit that is adapted to access one or more terms associated with one or more remote files over a network and encrypt one or more of the terms. Claim 15 further calls for the control unit to receive an encrypted search term from a user, compare the received encrypted search term with the encrypted accessed terms, and provide a result of the comparison over the network.

The Examiner relies on the combination of *Rajasekaran* and *Song* to reject claim 15 under 35 USC 103 for obviousness. Specifically, the Examiner argues that

**Rajasekaran** discloses accessing terms over a network and encrypting them, and **Song** discloses receiving an encrypted search term and comparing it to the encrypted accessed terms. See Office Action, p.15. Further, the Examiner asserts that the last claimed feature of providing a result of the comparison is taught by **Rajasekaran**. *Id.*

It is well established that, to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach all the claimed features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). In the present case, the Examiner has failed to meet this burden. For example, the Examiner improperly asserts that **Rajasekaran** discloses the last claimed feature of providing a result of the comparison. The term “comparison” in this claimed feature derives its antecedent basis from the previous claimed feature, which specifies comparing the received encrypted search term with the encrypted accessed terms. **Rajasekaran** does not disclose such a comparison, and, therefore, cannot and does not disclose the last feature of providing a result of the comparison, as specified in claim 15. In **Rajasekaran**, neither the search term (which the Examiner asserts corresponds to the “search term” in block 208) nor the accessed terms (which the Examiner asserts corresponds to “data structure” in block 204) is encrypted. To the contrary, **Rajasekaran** discloses at block 208 that the received request is not encrypted, and that the “data structure” is first decrypted (at 210) before any comparison is made to the search request at block 212. Thus, **Rajasekaran** discloses providing a result based on a comparison of an unencrypted search term to a **decrypted** data structure, whereas the claims call for providing a result of a comparison between an **encrypted** search term and **encrypted** accessed terms. For at least this reason, the

Examiner has failed to establish a prima facie case of obviousness. Claim 15 (and its dependent claims) and the other pending claims are allowable for at least this reason.

The pending claims are also allowable in view of the Examiner's misplaced reliance on the combination of ***Rajasekaran*** and ***Song***, which teach away from the claimed combination. The Examiner asserts that ***Song*** discloses receiving an encrypted search term and comparing it against a collection of encrypted terms. In other words, according to the Examiner, the comparison is between an encrypted search term and a collection of encrypted terms. The Examiner, however, fails to recognize that ***Rajasekaran***, the other reference upon which the Examiner relies, teaches exactly the opposite. In particular, as discussed earlier, ***Rajasekaran*** discloses receiving an unencrypted search request (at block 208) and comparing that search request against a collection of search terms ("data structure" in block 205) that are first decrypted (at block 210). Thus, in contrast to ***Song***, ***Rajasekaran*** teaches first decrypting the corpus of terms before any comparison. To modify the teachings of ***Rajasekaran*** in view of ***Song*** in the manner proposed by the Examiner would, therefore, render the searching scheme described in ***Rajasekaran*** inoperable for its intended purpose (i.e., being able to compare an unencrypted search request against a decrypted data structure). It is well established that where a modification or combination renders a prior art reference inoperable for its intended purpose, the reference teaches away from the modification or combination. *In re Gordon*, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984). As such, the Examiner's reliance on ***Rajasekaran*** and ***Song*** for an obviousness rejection is misplaced.

Claim 15 and its dependent claims are allowable for at least this additional reasons. The remaining claims are also allowable for similar reasons in view of the claimed features recited therein.

The Office Action suffers for additional shortcomings. For example, claim 20, which depends from claim 15, specifies the use of two databases (one for storing unencrypted accessed terms and the other for storing encrypted accessed terms) and further for providing a user with an option to search either of the two databases. The Examiner asserts that this feature is taught by *Rajasekaran* because it discloses a storage system having two memory subsystems. See Office Action, p. 4. Even assuming that the two memory subsystems correspond to “databases,” *Rajasekaran* still fails to teach that these memory subsystems are for storing both encrypted and unencrypted accessed terms. Moreover, *Rajasekaran* does not disclose providing a user with an option to search either the first or the second database. For at least this reason, claim 20 is allowable. Moreover, dependent claims 7 and 13 are allowable for at least the same reasons.

Reconsideration of the present application is respectfully requested.

In light of the arguments presented above, a Notice of Allowance is respectfully solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Houston, Texas telephone number (713) 934-4064 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

WILLIAMS, MORGAN & AMERSON, P.C.  
CUSTOMER NO. 46240

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By: /Ruben S. Bains/  
Ruben S. Bains, Reg. No. 46,532  
10333 Richmond, Suite 1100  
Houston, Texas 77042  
(713) 934-4064  
(713) 934-7011 (facsimile)

ATTORNEY FOR APPLICANT(S)